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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,846	10/23/2003	Winfried Reich	A-876 .com/kys	5386

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EXAMINER

STRIMBU, GREGORY J

ART UNIT	PAPER NUMBER
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3634

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/690,846

Applicant(s)

REICH ET AL.

Examiner

Gregory J. Strimbu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 36-57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 36-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### ***Drawings***

The drawing correction filed September 11, 2006 has been approved. However, the drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the pinion must be shown or the feature canceled from claim 40. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

Applicant is reminded of the proper language and format for an abstract of the disclosure.

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The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because "window sash" on line 4 is confusing since it is unclear whether or not the applicant is referring to one of the windows set forth above. On line 7, "the sash frame" is confusing since it is unclear if the applicant is setting forth that the sash frame has the vertical section while the door frame does not have the vertical section. On line 7, "[t]he forend rail" is confusing since it is not readily apparent to one with ordinary skill in the art what a forend rail is. Further clarification is requested to enable a reader to easily understand what is set forth in the disclosure. Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because of the following informalities: it appears that recitations such as "th Inv nti n" on line 1 of page 1 of the substitute specification filed January 14, 2004 are a typographical errors.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

Claims 36-57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with 35 USC 112 informalities. The applicant is requested to review and amend the claims to bring them into conformance with 35 USC 112, second paragraph, in light of the examples listed below.

Recitations such as “or” on line 2 of claim 36 render the claims indefinite because it is unclear which one of the two non-equivalent alternatives the applicant is attempting to positively set forth. Recitations such as “frame or sash element of the lift-slide sash or fame” on lines 4-5 of claim 36 render the claims indefinite because it is unclear if the frame is part of one of the lift-slide sash or the frame or both the lift-slide sash and the frame. Likewise it is unclear if the sash element is part of one of lift-slide sash or the frame or both lift-slide sash and the frame. Recitations such as “on sides” on line 10 of claim 36 render the claims indefinite because it is unclear what element of the invention includes the sides to which the applicant is referring. Recitations such as “the lift and slide frame” on lines 10-11 of claim 36 render the claims indefinite because it is unclear if the groove is only provided in the lift and slide frame and not provided in the lift-slide sash. Recitations such as “a ring axis” on line 2 of claim 39 render the claims indefinite because it is unclear what that applicant is attempting to set forth. Is the applicant referring to a center of a ring? Recitations such as “a casement plane” on line 4 of claim 39 render the claims indefinite because it is unclear what the applicant is

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attempting to set forth. How does a casement plane differ from a plane? Is the applicant referring to a plane of the sash? Recitations such as "is designed with" on line 2 of claim 40 render the claims indefinite because it is unclear if the invention actually includes a rack and pinion or is merely designed to have a rack and pinion. Recitations such as "the drive element" on line 3 of claim 40 and lines 1-2 of claim 47 render the claims indefinite because they lack antecedent basis. Recitations such as "runs in bearings" on lines 2-3 of claim 47 render the claims indefinite because it is unclear how the running shoe can run in bearings. It appears that the running shoe would run on bearings rather than in them. Recitations such as "in the area of the junction" on line 2 of claim 48 render the claims indefinite because they are grammatically awkward and confusing. Is the applicant referring to an actual area of the junction or is the applicant attempting to set forth that the coupling element is adjacent the two legs. Recitations such as "the longitudinal . . . of the running shoe" on lines 2-3 of claim 49 render the claims indefinite because it is unclear whether or not the applicant is referring to the longitudinal running shoe axis set forth in claim 37. Recitations such as "means" on line 3 of claim 50 render the claims indefinite because the applicant has attempted to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding or following "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967). Recitations such as "on" on line 3 of claim 53 render the claims indefinite because it is unclear how the curve is formed on the projection when it appears that the curve is

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formed in the projection. Recitations such as "works together" on line 3 of claim 53 render the claims indefinite because it is unclear what the applicant is attempting to set forth. Recitations such as "a rectangular profile" on line 2 of claim 56 render the claims indefinite because it is unclear what the applicant is attempting to set forth.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 36 is rejected under 35 U.S.C. 102(b) as being anticipated by von Resch. von Resch discloses a fitting 9, 21 for lift-slide sashes or lift-slide frames of doors or windows, comprising at least one forend rail 21, a drive rod 9 axially moveable on the forend rail and fastenable in a groove in a frame or sash element of the lift-slide sash or frame, wherein the forend rail 21 is a flat band, and wherein a width of the forend rail is greater than the width of the drive rod as shown in figure 4, so that the forend rail forms edge portions for bearing against contact surfaces which are formed by recesses on sides in a groove in a frame element of the lift and slide frame.

Claims 36-39, 41-43, 45, 46, 48, 56 and 57, as best understood by the examiner, are rejected under 35 U.S.C. 102(b) as being anticipated by German Patent No. 20 65 972. German Patent No. 20 65 972 discloses a fitting for lift-slide sashes or lift-slide

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frames of doors or windows, comprising at least one forend rail (not numbered, but shown in figure 1 as the left hand portion of the window frame 11 shown in cross section in figure 1), a drive rod 24 axially moveable on the forend rail and fastenable in a groove (not numbered, but shown in figure 1 as the space provided in the frame 11) in a frame 11 or sash element of the lift-slide sash or frame, wherein the forend rail is a flat band, and wherein a width of the forend rail as shown in figure 2 is greater than the width of the drive rod since the drive rod fits within the frame 11 so that the forend rail forms edge portions (not shown, but comprising the exterior edges of the frame 11) for bearing against contact surfaces (not shown, but comprising the sides of the fixed frame 10), a running shoe 12, a bearing element (not numbered, but comprising the corner of the frame 11), a coupling element 15, the coupling element has a first end (not numbered, but shown adjacent 21) and a second end (not numbered, but shown adjacent 18), the coupling element 15 is a partial ring since a portion of the coupling element is curved, i.e., ring shaped, and has an axis of rotation which is perpendicular to a casement plane, the coupling element second end engages a coupling opening (not numbered, but comprising the opening adjacent the pin 18 as shown in figure 1), an arc-shaped guide (not numbered, but comprising the arc-shaped protuberance supporting the pin 17 as shown in figure 1).

The limitations of claim 38 relating to how the casing of the running shoe is made are considered to be product-by-process limitations and, as such, are anticipated by the product of German Patent No. 20 65 972.



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Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over German Patent No. 20 65 972 as applied to claims 36-39, 41-43, 45, 46, 48, 56 and 57 above, and further in view of Haws. Haws discloses the use of a rack and pinion connection between a drive rod 58 and a driven element 56.

It would have been obvious to one of ordinary skill in the art to provide German Patent No. 20 65 972 with a rack and pinion connection, as taught by Haws, to increase the ease with which the drive rod can be connected and disconnected from the running shoe.

Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over German Patent No. 20 65 972 as applied to claims 36-39, 41-43, 45, 46, 48, 56 and 57 above, and further in view of Geiger. Geiger discloses a coupling element 28 made of metal as shown by the cross sectional shading in figure 4.

It would have been obvious to one of ordinary skill in the art to provide the coupling element of German Patent No. 20 65 972 with a metal construction, as taught by Geiger, to increase the strength of the coupling element.

Claims 47 and 51-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over German Patent No. 20 65 972 as applied to claims 36-39, 41-43, 45, 46, 48, 56 and 57 above, and further in view of European Patent No. 1 298 271. European Patent No. 1 298 271 discloses a bearing 14, 15 for supporting a running shoe 12, the bearing is located on a projection 7, a running shoe casing 2, as shown in figure 3, the

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projection 7 extends into the running shoe casing as shown in figure 3, the projection 7 includes a lifting curve 14', a guide bolt 15.

It would have been obvious to one of ordinary skill in the art to provide German Patent No. 20 65 972 with bearings, as taught by European Patent No. 1 298 271, to reduce the number of parts needed to manufacture the fitting.

Claims 49 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over German Patent No. 20 65 972 as applied to claims 36-39, 41-43, 45, 46, 48, 56 and 57 above, and further in view of European Patent No. 1 298 271. European Patent No. 1 298 271, in figure 6, discloses a running shoe casing comprising two walls 12, bearings 13' for two rollers 11, the walls 12 are connected via end walls 16.

It would have been obvious to one of ordinary skill in the art to provide German Patent No. 20 65 972 with a running shoe casing, as taught by European Patent No. 1 298 271, to increase the strength of the running shoe.

### ***Response to Arguments***

Applicant's arguments filed September 11, 2006 have been fully considered but they are not persuasive. With respect to the applicant's comments concerning German Patent No. 20 65 972, the examiner respectfully disagrees. German Patent No. 20 65 972 discloses a flat forend rail which comprises the portion of the frame 11 which forms the end of the sash. This portion of the frame is shown with cross sectional shading in figure 1 and includes the opening 43. Since the drive rod 24 is disposed within the

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frame 11, the forend rail must be wider than the width of the drive rod so that the drive rod can fit within the frame 11. Where the forend rail bends to join with the sides of the frame 11, the forend rail forms edge portions which extend beyond the drive rod. These end portions are adapted to bear against contact surfaces, i.e., surfaces of the stationary frame 10. The stationary frame 10 comprises a groove for receiving the forend rail. Recesses are formed where the side portions of the groove meet the base of the groove. These recesses form the contact surfaces with which the edges of the forend rail engage when the sash is in the closed position. Finally, German Patent No. 20 65 972 discloses a partial-ring shaped element since a portion of the coupling element 15 is curved. This curved portion of the coupling element is partially ring shaped.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. The applicant has presented new claims 36-57 which necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Strimbu whose telephone number is 571-272-6836. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Cuomo can be reached on 571-272-6856. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Gregory J. Strimbu  
Primary Examiner  
Art Unit 3634  
November 15, 2006